

REMARKS

This responds to the Office Action mailed on August 10, 2005.

At the outset Applicants assert that the Final Office Action immediately following the RCE with new amendments was not appropriate for the following reason. The amendments included subject matter not addressed at all by the Examiner, namely that command names are included within a string and the string represents a license and which includes “at least one of an inclusion and exclusion identifier.” The prior action asserted that an object in Goldick defined by a schema could include an inclusion or exclusion identifier, and although Applicants continue to disagree with this interpretation and application of Goldick; the prior action and teaching in Goldick provides no ability and no suggestion of a teaching where a same object could include both an inclusion and exclusion identifier for multiple commands within that same object, which is now how Applicants’ amended claims read. Applicants assert that this is subject matter, which was not addressed with the present action or in the previous Final Action. Therefore, the finality of this action is premature according to MPEP 7.06(b) and Applicants respectfully request that the Final be withdrawn.

§103 Rejection of the Claims

Claims 1, 6, 10, 15, and 22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Haruki (U.S. 2001/0013099 A1) and further in view of Goldick (U.S. 2002/0123992.). It is of course fundamental that in order to sustain an obviousness rejection that each and every element or step in the rejected claims must be taught or suggested in the proposed combination or references. It is also noted, that references are improperly combined if in doing so the Examiner uses improper hindsight or produces a combination that runs contrary to the teachings of the individual references.

Haruki is directed towards licensing techniques that manage and prevent dual installations of a software application. To achieve this, Haruki specifically relies on its ability to hide and mask the licensing data and management data from an application’s environment. The licensing data is encrypted and hidden on a specific device and in a hidden location. In fact,

Haruki states that an “electronic device has a secret area which cannot be accessed from a file system or the like . . . [l]icense data, and management data for managing a license data issue are prepared in the secret area.” Haruki, paragraph 9. The request for a license or management flag is made to a device that includes the licensing data; “license data [is]. . . necessary for installing the . . . software . . . [and] is managed by the . . . device.” Haruki, paragraph 32.

There is no teaching or suggestion of a teaching in Haruki for a license that has embedded software command names and that includes at least one of an inclusion and exclusion identifier. Haruki’s license works on a specific module or application and does not work on specific commands of an application. The purpose and teaching of Haruki are to avoid multiple installations of an application; and to achieve this, the licensing data, which is associated with a complete application, is hidden in a secret area of a device and controlled by the device outside the scope of the application and outside the scope of the users that attempt to install the application. If an installation is permitted, then a management flag is issued by the device that permits installation. If an installation is not permitted, then the management flag also indicates as much. Haruki globally controls installation of an application on a device. Haruki includes no ability to control individual commands within an existing installed application on a granular level, which is achievable and which is positively recited in Applicants’ independent claims.

These missing teachings are acknowledged by the Examiner; correspondingly, the Examiner asserts that the Goldick reference can be combined with Haruki to teach these missing limitations.

Goldick is directed to creating and managing version specific properties for objects in a distributed environment. The idea is that persistent information about an object can be directly obtained from the object itself without having to rely on external logs, services, or databases. The version specific properties are directly accessible with reference to the object. Essentially, an object carries its own log, such that that log can be accessed with reference to the object. In this manner, no external service or data structure has to be referenced to acquire versioning information about the object.

In Goldick each object’s versioning information is carried as metadata with the object. The definition of that metadata is represented as a schema; numerous examples of the schemas

and values for schemas are provided on pages 5-7 of Goldick. It is a premise of the Examiner that Goldick can be used to teach command names embedded within a string that include at least one of inclusion and exclusion identifiers; in support of this, the Examiner has cited two teachings from Goldick, namely paragraph 30 and the schemas listed on pages 5-7 of Goldick.

First, it is not clear at all to Applicants what relevance paragraph 30 has to the commands that are recited in Applicants' independent claims. This paragraph is clearly used to generally describe how a user interacts with input devices to achieve actions with a computer by selecting or inputting commands. The commands identified here are not registered software commands associated with a software license as is recited in Applicants' independent claims. So, it is not clear how it is that these commands have any relevance to Applicants' claimed commands.

Second, the cited schemas are data definitions for metadata properties associated with objects. The schemas are not for a license and not for a command, let alone a registered software command associated with a license.

Moreover, the schemas are for a single and sole property there is no aggregate schema for all properties. This is significant because even if the Examiner asserts that a license may be represented as a metadata property, then that license would necessarily have to include a sole application and not individual commands of an application, such that the commands are associated with at least one of an inclusion and exclusion identifier. Stated another way, Goldick defines a sole property in its schemas for single object, so multiple properties would be represented in multiple and different schemas not within a same string or same schema. Goldick cannot teach both an inclusion and exclusion within the same string.

It appears to Applicants that because the Goldick reference used the terms "inclusion" and "exclusion" that the Examiner decided this was sufficient to combine with Haruki for purposes of rendering Applicants' invention obvious. These terms are defined in the Goldick reference and have a specific meaning within Goldick. The inclusion reference refers to an object's metadata property which specifies a list of other properties for which an update should cause the version-specific property's contents to be set to empty. Haruki, page 6, item number 5. The exclusion reference refers to an object's metadata property which specifies a list of other

properties for which an update should not cause the version-specific property's contents to be set to empty. Haruki, page 7, item number 13.

Applicants respectfully do not understand how one of ordinary skill in the art would have read Goldick in view of Haruki and determined that object properties could really be registered software commands for a given application and identified within a license and associated with an inclusion and exclusion identifier. This could have only been achieved via improper hindsight, because the use of commands is different in Goldick from what the Examiner is relying on and the use of the terms "inclusion" and "exclusion" are different in Goldick from what the Examiner needs to rely on for purposes of rejecting Applicants' independent claims.

Applicants would also like direct the Examiner's attention to a very recent Federal Circuit case with respect to term interpretation. In *Phillips v. AWH Corporation*, 415 F.3d 1303 (Fed Cir. 2005) (*en banc*), the Court asserted that expansive interpretation of a term outside the scope of how that term was defined and used within an application's specification was inappropriate and therefore does not comport with the existing view of the Federal Circuit. A term's interpretation must be initially restricted to how it was defined and used within its corresponding specification if guidance was provided in that specification. Here, guidance was provided the use of the terms "inclusion" and "exclusion" are specific properties defined for a specific purpose in Goldick. Thus, the Examiner cannot expand this beyond the teachings of Goldick and in fact in contradiction to the teachings of Goldick for purposes of rendering Applicants' invention obvious.

Accordingly, the Examiner is not permitted to interpret the use of commands and "inclusion" and "exclusion" in manners that do not comport with the Goldick reference or in manners that run contrary to the Goldick reference. If a proper Goldick interpretation of the terms "inclusion" and "exclusion" is used within the confines of that reference, then it is clear the only way the proposed combination can be achieved in the manner proposed by the Examiner is via improper hindsight where it is made only after one of ordinary skill in the art has read and has comprehended Applicants' disclosure.

It is also noted that even if the proposed combination of Haruki and Goldick is made with improper hindsight in the manner suggested by the Examiner, it still is improper because it runs

contrary to the teachings of the individual references. Specifically, Haruki relies on hiding the license and a management flag, which includes an install status of the license, from an application within a secret area of a device, which controls the license. Conversely, Goldick keeps and desires to keep its version-specific properties with an object.

Haruki desires to separate an application from its license and management flag. Goldick desires to keep persistent information with an application (object) so external mechanisms and services do not have to be referenced. So, both teachings are violated in any proposed combination and therefore improper. Since, if Goldick's version-specific properties are separated and hidden from an application or object, then an external service or mechanism is necessary to access the persistent information; and doing this makes Goldick's invention less attractive and defeats the very stated purpose of Goldick. Similarly, if Haruki is modified to make the version-specific properties available with an application, then it defeats its entire teaching of secrecy and controlled access, which is why its installation techniques are beneficial in the first instance.

Therefore, the rejections are inappropriate and should be withdrawn because 1) the proposed combination lacks each and every teaching of the recited claims; 2) the proposed combination could have only been achieved with improper hindsight and with improper term interpretation; and 3) the proposed combination runs contrary to the teachings of both the individual cited references. Accordingly, Applicants respectfully request that the rejections be withdrawn and the claims allowed.

Claims 2-5, 9, and 11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Haruki and Goldick and further in view of Misra et al. (U.S. 6,189,146.). Claims 2-5, 9, and 11 are dependent from Applicants' independent claim 1; thus, for the remarks presented above with respect to the rejection of claim 1, the rejections of claims 2-5, 9, and 11 should be withdrawn.

Claims 7 and 8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Haruki and Goldick and further in view of Garst et al. (U.S. 6,188,995.). Claims 7 and 8 are dependent

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from Applicants' independent claim 1; thus, for the remarks presented above with respect to the rejection of claim 1, the rejections of claims 7 and 8 should be withdrawn.

Claim 12 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Haruki and Goldick and further in view of Muyres et al. (U.S. 2001/0010046 A1.). Claim 12 is dependent from Applicants' independent claim 1; thus, for the remarks presented above with respect to the rejection of claim 1, the rejection of claim 12 should be withdrawn.

Claims 13 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Haruki and Goldick and further in view of Carter et al. (U.S. 6,219,652.). Claims 13 and 14 are dependent from Applicants' independent claim 1; thus, for the remarks presented above with respect to the rejection of claim 1, the rejections of claims 13 and 14 should be withdrawn.

Claims 16-21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Haruki and Goldick and further in view of Misra et al. (U.S. 6,189,146.). Claims 16-21 are dependent from Applicants' independent claim 15; thus, for the remarks presented above with respect to the rejection of claim 15, the rejections of claims 16-21 should be withdrawn.

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CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney (513) 942-0224 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 11 day of October, 2005.

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